

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

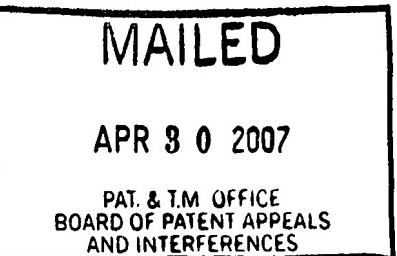
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FAISAL HAQ and HARI K. LALGUDI

Appeal 2007-0639
Application 09/483,110
Technology Center 2600

Decided: April 30, 2007



Before JAMES D. THOMAS, KENNETH W. HAIRSTON,
and ST. JOHN COURTENAY III, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1 through 6, 16 through 21, 31 through 43 and 52 through 57 among pending claims 1 through 64. We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a).

Representative independent claim 1 is reproduced below:

1. A method comprising:
receiving at least one packet; and
disposing of the received at least one packet in response to a walk of a Hash Table,
wherein
the Hash Table is balanced,
the Hash Table is configured to store Binary Comparison Trees, and
the Hash Table is configured to encode an Access Control List.

The following reference is relied on by the Examiner:

Dobbins US 5,509,123 Apr. 16, 1996

Claims 1 through 6, 16 through 21, 31 through 43 and 52 through 57 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dobbins.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

For the reasons set forth below we pro forma reverse the outstanding rejection of the claims on appeal under 35 U.S.C. § 102. Additionally, within the provisions of 37 § 41.50(b) we institute two new grounds of rejection of our own.

We reverse the outstanding rejection under 35 U.S.C. § 102 because the subject matter encompassed by the claims on appeal must be reasonably

understood without resort to speculation. Presently, speculation and conjecture must be utilized by us and by the artisan inasmuch as the claims on appeal do not definitely reflect what the disclosed invention is. Note In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Note also In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The ambiguities reflected in our new ground of rejection under 35 U.S.C. § 112, second paragraph, to be set forth later in this opinion, render the subject matter of representative independent claim 1 on appeal, for example, as fatally indefinite within this statutory provision and therefore lead us to conclude that it is inappropriate according to the just-noted case law to apply prior art to these claims in this condition. The parties appear to presume that positively stated features are recited in the claims where we find otherwise. Since this reversal should not be construed as a reversal on the merits, once properly definite claims are presented, Dobbins may be considered to be appropriate prior art to apply against those claims. Should this situation arise, however, we note from our own cursory review of Dobbins that this reference does not positively teach of a Hash Table and the data constructs disclosed that are intended to be associated with it.

With these considerations in mind, we reject all pending claims on appeal, claims 1 through 64, under the second paragraph of 35 U.S.C. § 112, within the provisions of 37 C.F.R. § 41.50(b). There are numerous instances in which representative independent claim 1 on appeal does not positively recite features. To begin with, the claimed Hash Table is not positively recited and there is no positively recited feature of walking through this Hash Table. On the contrary, only a future act of potential walking through

the Hash Table is set forth. This Hash Table is merely configured “to” store or “to” encode respective Binary Comparison Trees and an Access Control List. There is no positive statement that the Hash Table actually stores these elements or otherwise has encoded them in the present tense. The Hash Table is merely passively recited and the walking capability associated with it is a future act that may never occur as well as the “to store” and “to encode” capabilities of the Binary Comparison Trees and Access Control List. Significantly, the claim is not operative with respect to the claimed “disposing of” feature. There is no active disposition of anything recited in claim 1 that makes use of the fact that the Hash Table is considered to be balanced and any potential future configuration of the Binary Comparison Trees and Access Control List. Thus, at least with respect to these recitations, the metes and bounds of this claim are essentially arguable and not reasonably determinable, and this situation yields the lack of adequate notice to a potential infringer. Since independent claims 16 and 35 as well as 52 recite corresponding features, the rejection is extended to them as well as each of their respective dependent claims. Even though we recognize that the Hash Table is positively recited in independent claim 52, the other considerations we raised earlier also equally apply. It is not clear to us what the metes and bounds of claim 52 are if the claimed network station does not receive a packet. Likewise, the disposition feature at the end of the claim is said to be only broadly and indefinitely recited to occur “according to” additional features.

We also reject all pending claims on appeal under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Because of the manner in which the independent claims have been recited and, as indirectly reflected in the rejection we just set forth under the second paragraph of 35 U.S.C. § 112, what is left is that the claims merely passively recite an abstract data construct of a Hash Table and its attempted-to-be-defined data structures per se associated with it. Another view of the pending claims is that there is merely recited a data construct that may be configured to do something in the future. All claims on appeal, when considered in the context of the present and future embodiments contemplated at pages 25 and 26 of the Specification indicate that there is no limit to the nature of the subject matter that they are intended to encompass. This feature is most telling with respect to the broadly recited signal bearing media in independent claim 35 on appeal which is directly recited to encompass the mere transmission of intangible transmission media.

In summary, we have reversed the outstanding rejection of claims 1 through 6, 16 through 21, 31 through 43 and 52 through 57 rejected under 35 U.S.C. § 102. On the other hand, we have instituted two new grounds of rejection within the provisions of 37 C.F.R. § 41.50(b). These include the rejection of all pending claims, claims 1 through 64, under the second paragraph of 35 U.S.C. § 112 and a separate rejection of these claims under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

This decision contains two new grounds of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR §1.136(a). See 37 CFR § 1.136(a)(1)(iv).

REVERSED; 37 § 41.50(b)

PGC

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